

Notice of Allowability

Application No.

09/829,508

Examiner

Callie E. Shosho

Applicant(s)

WINTEROWD, JACK G.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 9/29/04 and telephonic interview conducted 10/13/04.
2. ☒ The allowed claim(s) is/are 1,3-6,9-13,15-22,24,26-28,33,43 and 44.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 12/15/03
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 10/13/04
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) Claim 43, line 10, after "preservative" and before "an", delete ",", and insert "or".

(2) Claim 43, line 10, after "brightener", delete ", a plasticizer, a dispersing aid, a coalescing aid, or a defoaming agent".

(3) Claim 44, line 10, after "preservative", delete ", a dispersing aid, a defoaming agent, or a coalescing agent" and insert "or an optical brightener".

2. Authorization for this examiner's amendment was given in a telephone interview with George Renzoni on 10/13/04.

Statement of Reasons for Allowance

3. The present claims are allowable over the “closest” prior art Coleman (U.S. 3,959,224), Kang et al. (U.S. 3,894,976), Bier (U.S. 4,792,357), and Winterowd et al. (U.S. 6,608,131) for the following reasons:

Coleman discloses water-based paint comprising latex, i.e. binder, titanium dioxide, surfactant, thickening agent such as hydroxyethylcellulose, dispersant, plasticizer, preservative, debonding agent, i.e. soybean oil, and defoamer. However, Coleman discloses the use of 9% soybean oil which is in direct contrast to present claims 1, 24, 43, and 44 that each require about 21 to about 50% debonding agent and present claim 33 that requires the use of about 17% soybean oil. Further, there is no disclosure of anionic surfactant comprising salt derived from morpholine and long chain carboxylic acid as required in all the present claims.

Kang et al. disclose water-based paint comprising binder, titanium dioxide, anionic surfactant, hydroxyethylcellulose, anti-foaming agent, biocide, fumed silica, and debonding agent, i.e. oil such as linseed oil, which comprises 5-65% of the binder solids. However, there is no disclosure or suggestion of soybean oil as required in present claims 24, 33, and 44. Further, there is no disclosure or suggestion that the debonding agent is present in amount of about 21 to about 50% as required in present claims 1 and 43. Further, there is no disclosure or suggestion of anionic surfactant comprising salt derived from morpholine and long chain carboxylic acid as required in all the present claims.

Bier discloses water-based paint comprising 10% hydroxyethylcellulose or carboxymethylcellulose, up to 20% titanium dioxide, up to 15% silicone oil, up to 2% surfactant, up to 5% fumed silica, up to 5% anti-foaming agent, preservative, and binder. However, there is

no disclosure of soybean oil as required in present claims 24, 33, and 44. Further, while Bier discloses the use of binder that is acrylic binder or vegetable oil such as linseed oil or rapeseed oil, there is no disclosure of using acrylic binder and vegetable oil as required in present claims 1 and 43. Further, there is no disclosure or suggestion of anionic surfactant comprising salt derived from morpholine and long chain carboxylic acid as required in all the present claims.

Winterowd et al. disclose composition comprising 10-25% binder, 2-30% vegetable oil such as soybean oil, 1-4% surfactant that comprises morpholine and long chain acid which is stearic acid, 0.1-0.8% viscosity enhancing agent such as carboxymethylcellulose, 0.1-1% titanium dioxide, dispersing agent, preservative, and water. However, all the present claims recite "consisting essentially of" transitional language. It is noted that "consisting essentially of" limits the scope of the presently claimed paint composition to the specifically claimed ingredients and those that do not materially affect the basic and novel characteristics of the paint. However, in addition to the above ingredients, Winterowd et al. always requires that the composition contains wax which would materially affect the basic and novel characteristics of the composition and thus, the composition of Winterowd et al. falls outside the scope of the present claims.

Thus, it is clear that Coleman, Kang et al., Bier, and Winterowd et al., either alone or in combination, do not disclose or suggest the present invention.

Further, applicant's amendment filed 9/29/04 overcomes the 35 USC 112, 2nd paragraph rejections of record.

In light of the above, the present claims are passed to issue.

Applicants IDS filed 12/15/03 has been considered. It is noted that Winterowd et al. (U.S. 6,608,131) has been stricken from the IDS as redundant given that it is also cited on the PTO-892 mailed 1/26/04. The present claims are allowable over the "closest" prior art cited in the IDS for the following reasons.

Friel et al. (U.S. 2003/0110101) discloses paint comprising opacifying agent, binder, coalescing agent, surfactant, and water. However, while Friel et al. disclose the use of debonding agent that is mineral oil, there is no disclosure or suggestion of vegetable oil as required in present claims 1 and 43 and no disclosure or suggestion of soybean oil as required in present claims 24, 33, and 44.

EP 625541 discloses paint comprising water, opacifying agent, acrylic latex, coalescing agent, defoamer, and viscosity enhancing agent. However, there is no disclosure or suggestion of debonding agent comprising vegetable oil or soybean oil as required in present claims 1, 24, 43, and 44 and no disclosure of soybean oil as required in present claim 33.

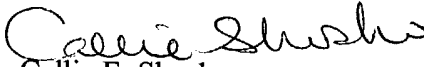
Suk (U.S. 4,265,797) discloses water-based paint comprising propellant, binder, water, coalescing agent, and anti-foaming agent that is mineral oil or silica. However, there is no disclosure or suggestion of debonding agent comprising vegetable oil or soybean oil as required in present claims 1, 24, 43, and 44 and no disclosure of soybean oil as required in present claim 33.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
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